No. 15-446

IN THE
Supreme Court of the United States

CUOZZO SPEED TECHNOLOGIES, LLC,
Petitioner,
v.
MICHELLE K. LEE,
Respondent.

On Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

BRIEF OF DELL, ACUSHNET, ALLIANCE OF AUTOMOBILE MANUFACTURERS, APPLIED MATERIALS, ASUSTEK, BJ'S WHOLESALE CLUB, CANON, CCIA, CISCO SYSTEMS, CTIA, DEMANDWARE, DROPBOX, EBAY, FAIRCHILD SEMICONDUCTOR, GLOBAL AUTOMAKERS, GOOGLE, HPE, HTC, INTEL, THE INTERNET ASSOCIATION, JCPENNEY, L BRANDS, LIMELIGHT NETWORKS, LINKEDIN, MICRON, NATIONAL RETAIL FEDERATION, NETFLIX, NEWEGG, PEGASYSTEMS, QVC, RACKSPACE, RED HAT, RICOH, SAMSUNG, SAP, SAS, SEAGATE, SYMMETRY, TOYOTA, VARIAN, VIZIO, AND XEROX AS *AMICI CURIAE* IN SUPPORT OF RESPONDENT

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INTEREST OF *AMICI CURIAE*[1]

Amici are technology companies, manufacturers, trade associations of Internet, automotive, computer, and communications companies, and retailers that use and sell high-tech products. We represent $7.5 trillion of market capitalization and employ many of the world's most innovative computer scientists and engineers. Most *amici* hold substantial patent portfolios and share the interest of some of petitioner's *amici* in high-quality patents that represent genuine additions to the public storehouse of knowledge – but also have a strong interest in supporting processes Congress has created to purge poor-quality patents that function only as a private tax on public innovation.

Amici file this brief to express their strong support for post-grant proceedings such as the *inter partes* review process passed by Congress and implemented by the Patent and Trademark Office ("PTO") and its Director. That process is working well to reduce patent overbreadth and eliminate invalid patents. The issues before the Court – the PTO's use of the broadest reasonable construction of claim terms, and the statutory bar on appeals of decisions to institute *inter partes* review – are important parts of that process, and *amici* urge the Court not to disturb the correct results reached by the agency and the lower courts.

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[1] Pursuant to Supreme Court Rule 37.6, counsel for *amici* represent that they authored this brief in its entirety and that none of the parties or their counsel, nor any other person or entity other than *amici* or their counsel, made a monetary contribution intended to fund the preparation or submission of this brief. Pursuant to Rule 37.3(a), counsel for *amici* represent that all parties have consented to the filing of this brief. Petitioner has filed a letter with the Clerk granting blanket consent to the filing of *amicus* briefs; written consent of respondent is being submitted contemporaneously with this brief.

INTRODUCTION AND SUMMARY

In creating *inter partes* review, Congress sought to provide "a meaningful opportunity to improve patent quality and restore confidence in the presumption of validity that comes with issued patents in court." H.R. Rep. No. 112-98, pt. 1, at 48 (2011). New statutory tools to improve patent quality were and are urgently needed. *Amici* know from experience that poor-quality patents pose a major problem for American innovators. Among the many defects of such patents is unacceptable vagueness: claims and claim terms that can reasonably be read in more than one way and whose scope varies greatly depending on the construction they receive.

Inter partes review provides a relatively quick and cost-effective method to eliminate poor-quality patents, as an alternative to (but not an exact substitute for) district court proceedings. The PTO's rule that is challenged here looks to the "broadest reasonable construction," 37 C.F.R. § 42.100(b), of a challenged patent claim when determining its patentability. That rule plays an important role in the function of *inter partes* review. The Director's brief has ably demonstrated how the PTO's rule embodies the best interpretation of the statutory text and structure, *see* Gov't Br. 17-34, and certainly one well within the agency's interpretative leeway, *see id.* at 34-43. *Amici* focus in this brief on the policies supporting the rule and on its practical effects.

The PTO's broadest-reasonable-construction rule stands for a simple but important policy. If a challenged patent claim can reasonably be read to encompass prior art or obvious variants of prior art, the claim should not stand. If the patent holder can cure that flaw through amendment, it should; if not, the

PTO should cancel the claim. By doing so, the agency protects the principle that a "patent holder should know what he owns, and the public should know what he does not" – so that others may "pursue innovations, creations, and new ideas beyond the inventor's exclusive rights." *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 731 (2002).

Petitioner's criticisms of the PTO's rule underestimate its benefits and overstate its differences from district court claim construction. A district court and the Patent Trial and Appeal Board (the "Board") consider the same information when construing patent claims: the language of the claims, the specification that describes the invention the claims protect, the prosecution history of the patent, and other intrinsic and extrinsic materials that shed light on the claims' meaning. The difference occurs at the end of the construction process, if there is still a choice among multiple reasonable constructions of the claim language. In such situations, a district court does not necessarily pick the broadest reasonable construction; there is even authority that it should favor a narrower construction to preserve the patent's validity. By contrast, the Board adopts the broadest reasonable construction, even if that leads (absent appropriate narrowing amendments) to cancelling the patent claims. That difference is appropriate to the role of the PTO as the agency that issues patents and is responsible in the first instance for protecting the public from patents that never should have issued. It also gives patent applicants and holders a necessary incentive to make patent claims clear.

Inter partes review is working well so far. That new process has not been the radical transformation in patent law depicted by petitioner and its *amici*. During

the four-year period following Congress's creation of *inter partes* review, the PTO issued 1 million new patents; 15,000 patents were asserted in district court cases; fewer than 3,000 patents were challenged in *inter partes* review or similar proceedings; and 535 patents had one or more of their claims cancelled.[2] If anything, the PTO should be doing more. The rates at which the PTO institutes *inter partes* reviews and cancels patent claims are flattening or dropping over time, suggesting (as one would expect) that initial cases focused on the weakest patent claims. The Board's decisions have also had high affirmance rates in the Federal Circuit, showing that the agency is making careful decisions.

The Director is also correct on the second question presented, which concerns whether a disappointed patent holder can appeal the agency's determination whether to institute an *inter partes* review. The statute is clear that such a determination is final and non-appealable. *See* Gov't Br. 44-50. Petitioner's attempts to read it otherwise lack merit. Institution determinations should be reviewable only by mandamus.

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[2] Through the end of 2015, the PTO reached final decisions in 714 petitions for *inter partes* review or similar covered business method review, regarding 597 patents. Those decisions cancelled one or more challenged claims in 535 patents. *See* https://ptabtrials.uspto.gov (collecting decisions).

ARGUMENT

The America Invents Act ("AIA") defines certain characteristics of the new *inter partes* review procedure it creates, but not others. For example, it establishes certain specific grounds for "cancel[ling]" a patent "as unpatentable" – only grounds "under [35 U.S.C. §§] 102 or 103," and only "on the basis of prior art consisting of patents or printed publications." 35 U.S.C. § 311(b). It provides a threshold standard for initiating the review: "a reasonable likelihood that the petitioner would prevail" at least in part. *Id.* § 314(a). It authorizes the "Patent Trial and Appeal Board," in particular, to "conduct each inter partes review." *Id.* § 316(c). It directs that an *inter partes* review petitioner "ha[s] the burden of proving a proposition of unpatentability by a preponderance of the evidence," *id.* § 316(e), rather than by clear and convincing evidence as would be required in district court. It does not, however, expressly prescribe a claim-construction standard for the Board to use.

Exercising her broad authority to "prescribe regulations" "establishing and governing inter partes review," *id.* § 316(a)(4), the Director has adopted a regulation under which the Board gives "[a] claim in an unexpired patent its broadest reasonable construction in light of the specification of the patent in which it appears," 37 C.F.R. § 42.100(b). Her brief ably shows that is the best reading of the statute, *see* Gov't Br. 17-34, and certainly a reasonable one that deserves judicial deference, *see id.* at 34-43. This brief, drawing from *amici*'s experience as patent holders, patent challengers, and participants in PTO proceedings, focuses on the substantial reasons supporting the Director's determination that § 42.100(b) serves her mandate to promote innovation.

I. THE PTO'S STANDARD HELPS ENSURE THAT PATENTS GIVE FAIR NOTICE

The broadest-reasonable-construction standard ensures that patents give fair notice of the inventions that they seek to remove from the public domain – that is, inventions as to which a potential maker, user, or seller might reasonably expect to face an infringement action. To achieve that result, the PTO applies the same general principles that a district court would apply in construing the same claim. The difference is that, if those principles lead to more than one reasonable construction, the PTO picks the broader alternative. By doing so, the agency's review of a patent captures all reasonable readings that the patent holder might later adopt when seeking to enforce that patent or that an innovator might consider when seeking to avoid infringement.

A. Courts and the PTO Apply the Same General Claim-Construction Principles

The Federal Circuit's en banc decision in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005), sets out the modern claim-construction framework. The touchstone of claim construction is "the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention." *Id.* at 1313. Where the meaning of the claim itself is "not immediately apparent," courts look to intrinsic sources such as "'the words of the claims themselves, the remainder of the specification, [and] the prosecution history,'" and "'extrinsic evidence concerning relevant scientific principles, the meaning of technical terms, and the state of the art.'" *Id.* at 1314 (citation omitted). The use of intrinsic materials such as the specification and prosecution history to shed light on claim terms is well grounded in decisions of this

Court;[3] as *Phillips* further noted, such intrinsic sources are generally more "reliable" than extrinsic ones. *Id.* at 1318.

The PTO determines "the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art." *In re Morris*, 127 F.3d 1048, 1054-55 (Fed. Cir. 1997). It "tak[es] into account whatever enlightenment by way of definitions or otherwise may be afforded by the written description contained in the applicant's specification," *id.*, just as a court would do. The Federal Circuit has repeatedly confirmed that, whether a court or the PTO is reading claims, they "should always be read in light of the specification and teachings in the underlying patent." *In re Suitco Surface, Inc.*, 603 F.3d 1255, 1260 (Fed. Cir. 2010); *see also Phillips*, 415 F.3d at 1316-17 (noting that courts rely on the specification in part because the agency does so when it issues a patent).[4] The PTO also considers

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[3] *See United States v. Adams*, 383 U.S. 39, 48-49 (1966) ("While the claims of a patent limit the invention, and specifications cannot be utilized to expand the patent monopoly, it is fundamental that claims are to be construed in the light of the specifications and both are to be read with a view to ascertaining the invention.") (citations omitted); *Graham v. John Deere Co.*, 383 U.S. 1, 33 (1966) ("[A]n invention is construed not only in the light of the claims, but also with reference to the file wrapper or prosecution history in the Patent Office.").

[4] *See also TriVascular, Inc. v. Samuels*, 812 F.3d 1056, 1062 (Fed. Cir. 2016) ("Construing individual words of a claim without considering the context in which those words appear is simply not 'reasonable.' Instead, it is the 'use of the words in the context of the written description and customarily by those of skill in the relevant art that accurately reflects both the "ordinary" and "customary" meaning of the terms in the claims.' ") (citation omitted); *In re NTP, Inc.*, 654 F.3d 1279, 1288 (Fed. Cir. 2011) (the "broadest reasonable construction cannot be divorced from

a patent's prosecution history in determining reasonable claim constructions. *See* Gov't Br. 35 n.8.[5]

A reviewing court will not accept a construction that is "unreasonably broad," *Suitco*, 603 F.3d at 1260, in light of the claims, specification, and prosecution history *See also* Manual of Patent Examining Procedure § 2111 (9th ed. rev. Nov. 2015) ("The broadest reasonable interpretation does not mean the broadest possible interpretation."). In the rare cases where the PTO has exceeded the bounds of reasonableness, the Federal Circuit has said so. *See, e.g., PPC Broadband, Inc. v. Corning Optical Commc'ns RF, LLC*, No. 2015-1364, 2016 WL 692369, at *2 (Fed. Cir. Feb. 22, 2016) (holding that the PTO's construction of one claim term was unreasonable under any standard); *Proxyconn*, 789 F.3d at 1298-1300 (same).

Petitioner's attempt to characterize construction by a court as fundamentally different from construction by the PTO under the broadest-reasonable-construction standard – *see, e.g.*, Br. 17 (describing judicial construction as "what claims *actually* mean" and construction by the PTO as "what they hypo-

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the specification and the record evidence"); *Rowe v. Dror*, 112 F.3d 473, 480 (Fed. Cir. 1997) (giving claims "their broadest reasonable meaning does not relieve the PTO of its essential task of examining the entire patent disclosure to discern the meaning of claim words and phrases").

[5] *See also, e.g., Microsoft Corp. v. Proxyconn, Inc.*, 789 F.3d 1292, 1298 (Fed. Cir. 2015) ("The PTO should also consult the patent's prosecution history in proceedings in which the patent has been brought back to the agency for a second review."); *Tempo Lighting, Inc. v. Tivoli, LLC*, 742 F.3d 973, 977 (Fed. Cir. 2014) ("[T]he prosecution history, while not literally within the patent document, serves as intrinsic evidence for purposes of claim construction. This remains true in construing patent claims before the PTO.").

thetically *might* mean") – is thus misguided. Both procedures are governed by the same "general claim construction principles." *Proxyconn*, 789 F.3d at 1298. They reach different results only where those of skill in the art, having read the claims, the specification, the prosecution history, and relevant prior art, might reasonably disagree about the scope of a patent's claim. In such close cases, courts do not favor the broader construction; there is even authority that they should break ties in favor of a narrower construction. *See Phillips*, 415 F.3d at 1327-28 (discussing *Klein v. Russell*, 86 U.S. (19 Wall.) 433, 466 (1874), and the "doctrine of construing claims to preserve their validity"); *see also* Gov't Br. 19, 28. The PTO, by contrast, adopts the broadest reasonable construction, which may require the patent owner to narrow claims or face a stronger challenge to patentability.

There are good reasons – grounded in the particular institutional roles of courts and agencies – for that difference in approach. A generalist court considers the validity of a patent after taking into account that the patent has already been granted by an agency. It must "presume[], until the contrary is made to appear, that the commissioner did his duty correctly in granting [a] patent." *Klein*, 86 U.S. (19 Wall.) at 463. The PTO, by contrast, has the "specific authority and expertise" in patent law needed to determine whether a patent should initially be granted. *Kappos v. Hyatt*, 132 S. Ct. 1690, 1696 (2012). This "special expertise in evaluating patent applications," *id.* at 1700, means that the agency also has the expertise to later "reconsider its own decisions" from a fresh perspective if necessary, according to procedures established by Congress. *MCM Portfolio LLC v. Hewlett-Packard Co.*, 812 F.3d 1284, 1291 (Fed. Cir. 2015). The agency

is also better able than is a court to consider the interest of the public in whether to grant, deny, or cancel patent claims. Especially relevant here is the public interest in clear notice of patent boundaries, which the agency's claim-construction approach protects.

B. Using the Broadest Reasonable Construction in PTO Proceedings Helps Give the Public Clear Notice of Patent Boundaries

1. The PTO's Rule Helps To Enforce the Notice Function of Patents

The Patent Act "attempts to maintain" a "delicate balance between inventors, who rely on the promise of the law to bring the invention forth, and the public, which should be encouraged to pursue innovations, creations, and new ideas beyond the inventor's exclusive rights." *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 731 (2002). The requirement that "inventors describe their work in 'full, clear, concise, and exact terms,'" *id.* (quoting 35 U.S.C. § 112(a)), is a key part of that balance. *See id.* at 730-31 ("[C]larity is essential to promote progress, because it enables efficient investment in innovation. A patent holder should know what he owns, and the public should know what he does not."); *see also* Fed. Trade Comm'n, *The Evolving IP Marketplace* 75 (Mar. 2011) ("[n]otice promotes the invention, development, and commercialization of innovative products"). The PTO, whose mandate is to promote innovation, must give fair weight to both sides of the statutory balance.

When the bounds of a patent claim are susceptible to more than one reasonable reading, a "'zone of uncertainty'" exists "'which enterprise and experimentation may enter only at the risk of infringement claims.'" *Nautilus, Inc. v. Biosig Instruments, Inc.*, 134 S. Ct. 2120, 2129 (2014) (quoting *United Carbon*

Co. v. Binney & Smith Co., 317 U.S. 228, 236 (1942)). Some uncertainty is unavoidable, because of the limits of language: the Patent Act's "definiteness requirement mandates clarity, while recognizing that absolute precision is unattainable." *Id.*, *see also Teva Pharm. USA, Inc. v. Sandoz, Inc.*, 135 S. Ct. 831, 839 (2015) (noting that "divergent claim construction stemming from divergent findings of fact [may] occur"). Nevertheless, clear lines are the goal, and patents that fall short of drawing such lines burden the parties and courts that must construe them – and, more importantly, the public generally.

Unclear patents are too common. From mid-2005 to 2011, the Federal Circuit disagreed with a district court's construction of at least one claim term in 29.5% of appeals involving claim construction.[6] A more recent review shows complete reversals on 31% of claim-construction issues presented during the 2014-2015 term, and partial reversals in an additional 19%.[7] During that same Federal Circuit term, patent holders won only 38% of claim-construction issues.[8] Thus, at least at the appellate level, litigation over ambiguity most often involves a patent holder's incorrect (whether or not reasonable) reading of its own patent.

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[6] *See* J. Jonas Anderson & Peter S. Menell, *Informal Deference: A Historical, Empirical, and Normative Analysis of Patent Claim Construction*, 108 Nw. U. L. Rev. 1, 40 (2014). That is an improvement: from 2001 to mid-2005, such disagreements occurred in 40.6% of claim-construction appeals. *See id.*

[7] *See* Gibson, Dunn & Crutcher LLP, *Federal Circuit Year in Review: 2014/2015*, at 9, http://www.gibsondunn.com/publications/Documents/Federal-Circuit-2014-2015-Year-in-Review.pdf.

[8] *See id.* at 6. Another 16% of claim-construction issues were won in part by one party and in part by the other. *See id.*

The PTO's longstanding practice of looking at the broadest reasonable construction of patent claims is designed to ensure that patents are clear and that patent holders have an incentive to make them clear. As the Director explains (at 18-20), the agency has given claims under examination "the broadest interpretation they will support" for more than a century, *Podlesak v. McInnerney*, 1906 Dec. Comm'r Pat. 265, 268, and has applied that standard in other contexts including *ex parte* reexamination, *inter partes* reexamination (the direct precursor to *inter partes* review), interference proceedings, and reissue proceedings, *see* Gov't Br. 20-22; *see also* Pet. App. 32a-34a.

The PTO's approach properly places on the patent applicant or owner the "burden of precise claim drafting," *Morris*, 127 F.3d at 1056, so as to promote the "public interest" in "reducing the possibility that claims, finally allowed, will be given broader scope than is justified." *In re Yamamoto*, 740 F.2d 1569, 1571 (Fed. Cir. 1984). As this Court has recognized, those drafting patents "face powerful incentives to inject ambiguity into their claims," and the patent system needs rules to "[e]liminat[e] that temptation." *Nautilus*, 134 S. Ct. at 2129. Congress had these incentives in mind when it devised the *inter partes* review procedure. *See* 157 Cong. Rec. S1375 (Mar. 8, 2011) (Sen. Kyl) (explaining that a provision allowing the PTO to review documents filed by the patentee in district court would "allow the Office to identify inconsistent statements made about claim scope – for example, cases where a patent owner successfully advocated a claim scope in district court that is broader than the 'broadest reasonable construction' that he now urges in an inter partes review").

The PTO's use of the broadest reasonable construction reflects a policy decision that the PTO should not issue patent claims that can reasonably be construed to encompass the earlier inventions of others; and, if the PTO later finds it has issued such a claim, it should permit narrowing of the claim or cancel it. That approach not only is within the agency's leeway to interpret the statute, but also promotes innovation outside the patent's bounds.

2. The Ability To Amend Patent Claims Ensures Fairness to Patent Holders

Placing the burden of clarity on patent holders is also fair to the holders themselves.[9] *See Nautilus*, 134 S. Ct. at 2129 ("'[T]he patent drafter is in the best position to resolve the ambiguity in patent claims.'") (quoting *Halliburton Energy Servs., Inc. v. M-I LLC*, 514 F.3d 1244, 1255 (Fed. Cir. 2008)) (alteration in

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[9] For a number of the *amici* supporting petitioner, their position in this Court is a change from what they originally urged the PTO to do. In comments to the PTO following enactment of the AIA, representatives of major patent holders including 3M, Johnson & Johnson, Abbott Laboratories, GlaxoSmithKline, and Pfizer proposed that new rules governing *inter partes* review should continue using the PTO's "existing rules for contested cases As is the case currently in [contested PTO] proceedings, in the new proceedings the standard for claim construction shall be the 'broadest reasonable construction.'" Comments and Proposed Regulations of the Committee Appointed by the ABA IPL, AIPLA and IPO Relating to Post-Grant Review, Inter Partes Review and Transitional Program for Covered Business Method Patents Under the Leahy-Smith America Invents Act at 12 (Nov. 18, 2011), http://www.uspto.gov/sites/default/files/patents/law/comments/x_aia-a_abaaiplaipo_20111118.pdf. Those commenters also cited the statutory delegation of rulemaking powers to the Director as supporting application of the broadest-reasonable-construction standard. *Id.* at 58 (citing 35 U.S.C. § 326(a)(2), (b)).

original). The patent holder (or its predecessor) controls the initial drafting and can amend at will during that process. It can also initiate reissue proceedings to amend if it discovers an error that affects patentability, *see* 35 U.S.C. § 251, such as if a patent has inadvertently been drafted to claim too much subject matter.

Even during an *inter partes* review proceeding, where the rights of a specific opposing party are at stake, the patent holder can amend to "propose a reasonable number of substitute claims," *id.* § 316(d)(1)(B), so long as the amendment "respond[s] to a ground of unpatentability involved in the trial," 37 C.F.R. § 42.121(a)(2)(i). And the PTO permits additional motions to amend a claim for good cause. *See id.* § 42.121(c); *see also* 35 U.S.C. § 316(d)(2) ("[a]dditional motions to amend may be permitted" to facilitate settlements "or as permitted by regulations prescribed by the Director"). Thus, the patent holder has the opportunity to narrow its claims to remove any construction the PTO might adopt that covers ground the holder does not actually intend to claim. Where the patent holder does not have that opportunity (because the patent has expired and cannot be amended), the agency will not apply the broadest-reasonable-construction standard. *See* Gov't Br. 22 & n.3.

Petitioner and some *amici* complain that Congress and the Board have not been sufficiently generous with amendments during *inter partes* review. Pet. Br. 29-31. For example, *amicus* IBM, although supporting the broadest-reasonable-construction standard in principle, contends that the Board's "practice" at present makes it "difficult for patentees to amend claims successfully during *inter partes* review." IBM Br. 17. Among other things, IBM objects to the requirement

that a patent holder must "'persuade the Board that [a] proposed substitute claim is patentable over the prior art of record, and over prior art not of record but known to the patent owner.'" *Id.* at 18 (quoting *Idle Free Sys., Inc. v. Bergstrom, Inc.*, Case IPR2012-00027(JL), 2013 WL 5947697, at *4 (P.T.A.B. June 11, 2013)). Those criticisms of amendment practice before the Board are irrelevant to this case; and, regardless, the Board's practice is reasonable.

First, the standard for permitting amendments is not under review. *See* Gov't Br. 27. The availability of amendment as a statutory matter is relevant because it reinforces the point that *inter partes* review is an administrative proceeding similar to reissue, interference, or the old *inter partes* reexamination process, and it shows that Congress would have had in mind existing precedent about claim-construction standards in such proceedings. *See id.* at 20-22. But the standard under which the Board permits amendment is not similarly relevant. If the Board were being unduly strict about amendments, that standard could be clarified by the Federal Circuit (or ultimately by this Court) in a case where it mattered.[10]

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[10] Likewise, the PTO's choice to develop its claim amendment practice initially through case-by-case adjudications rather than through rulemaking, *see* IBM Br. 19, is not under review. Normally, an agency's "choice between rulemaking and adjudication lies in the first instance within the [agency's] discretion." *NLRB v. Bell Aerospace Co. Div. of Textron Inc.*, 416 U.S. 267, 294 (1974). The PTO nonetheless has "committed" to "continue to make improvements and clarifications via the rule-making process, by updating the Office Patent Trial Practice Guide, and by designating opinions as precedential or informative, as warranted." Amendments to the Rules of Practice for Trials Before the Patent Trial and Appeal Board, 80 Fed. Reg. 50,720, 50,722-23 (Aug. 20, 2015) ("Board Rule Amendments").

Second, the Board's practice of requiring a patent holder to bear the burden of persuasion in seeking to demonstrate that its proposed amendment will cure the identified problems with its patent, *see Idle Free*, 2013 WL 5947697, at *4, is hardly "extraordinary," IBM Br. 19. Placing the burden on the patent holder is in line with the statutory requirements that the patent holder must "move to amend the patent," 35 U.S.C. § 316(a)(9), and that the Director shall incorporate only those amended claims that are "determined to be patentable," *id.* § 318(b). It is also consistent with the general rule that "[t]he moving party has the burden of proof to establish that it is entitled to the requested relief." 37 C.F.R. § 42.20(c).

When *inter partes* review begins, the challenger to a patent has already established a "reasonable likelihood" that the Board will cancel the challenged patent claims. 35 U.S.C. § 314(a); *see infra* pp. 18-19. Once the challenger has met that initial burden and the PTO has instituted review, it makes sense to ask the patent holder to provide some affirmative reason to think that its substitute claims are patentable despite the apparent unpatentability of its original ones. There is no opportunity for separate PTO examination of newly proposed substitute claims in these proceedings. *See* Board Rule Amendments, 80 Fed. Reg. at 50,723, 50,724. The challenger, similarly, may have no interest in resisting the proposed substitute claims (if, for example, the amendment sufficiently protects that particular challenger). If the burden were not on the patent holder, an amended patent could issue despite known prior art showing the amended claims are unpatentable. *See Proxyconn*, 789 F.3d at 1307-08.

Third, the fact that relatively few amendments have been made or granted to date can also be explained by

incentives to amend sparingly. One reason a patent holder may be reluctant to amend to cure overbreadth is that it may be depending on a broad reading of the patent claim to establish infringement in parallel or contemplated infringement proceedings. In such circumstances, patent holders may make a tactical choice to risk the whole claim rather than narrow it to cover only what is patentable, or may attempt a narrowing that the Board ultimately finds does not go far enough to cure the problem.

A patent holder may also be reluctant to use the amendment process because that would open the door to claims of intervening rights by alleged infringers. Section 318(c) provides that an amendment during *inter partes* review "shall have the same effect as that specified in section 252 for reissued patents" on the rights of those who made, purchased, or used the patented invention before the Board's final written decision. 35 U.S.C. § 318(c). Section 252, in turn, provides that – subject to certain limitations – reissued patents "shall not abridge or affect the right" of others to make, use, or sell the patented technology. *Id.* § 252. Thus, where a patent holder is already asserting a patent in litigation against past alleged infringers, it may be reluctant to propose an amendment that might give up its rights against them. But that is the result that Congress prescribed for amendment of unpatentable claims in *inter partes* review and similar proceedings. That some patent holders dislike Congress's rule is not a valid criticism of the Board.

Fourth, and finally, amendment during an *inter partes* review is not a patent holder's first chance to draft clear claims. It is a last chance after several others. *See supra* pp. 13-14. If after those multiple opportunities a patent claim still has a reasonable

reading under which it fails scrutiny, it is fair for the Board to conclude that the patent holder does not truly desire a patentably narrower claim.

II. THE PTO'S STANDARD HELPS IT IMPROVE PATENT QUALITY

Congress created *inter partes* review "to ensure that the poor-quality patents can be weeded out through administrative review," 157 Cong. Rec. S5409 (Sept. 8, 2011) (Sen. Schumer), and to serve as "a cheaper, quicker, better alternative to resolve questions of patentability" as opposed to "costly litigation in Federal court," *id.* at H4495 (June 23, 2011) (Rep. Smith). The PTO's approach of looking to the broadest reasonable construction of unclear claim terms furthers those goals in several ways.

1. Several characteristics of the *inter partes* review proceeding confirm that Congress intended it specifically to target poor-quality patents. The PTO's adoption of the broadest-reasonable-construction standard harmonizes with those characteristics.

First, the AIA creates a formidable screening mechanism before review is instituted. *Inter partes* review requires a preliminary finding by the Director of a "reasonable likelihood" that the petitioner will prevail as to at least one claim. 35 U.S.C. § 314(a). The petitioner must establish that likelihood "on the basis of prior art consisting of patents or printed publications," *id.* § 311(b), a relatively narrow set of easily accessible materials. If the Director does not agree that the petitioner has a reasonable likelihood of success, her refusal to institute a proceeding is "final and nonappealable." *Id.* § 314(d). Those provisions show that Congress intended the agency to take a relatively quick initial look at the merits and to limit *inter partes* review to situations where that look raises serious

doubts about whether the patent should ever have been granted.

Second, after that initial threshold showing is made, *inter partes* review subjects the challenged claims to thorough scrutiny. Although in district court the invalidity of a patent must be established by clear and convincing evidence, before the Board it may be established by a preponderance of the evidence. *Id.* § 316(e). That evidentiary standard indicates that patents undergoing *inter partes* review should not have the presumption of validity that they would receive in a district court challenge. *Cf. Microsoft Corp. v. i4i Ltd. P'ship*, 131 S. Ct. 2238, 2246 (2011) (noting that the requirement for proof of invalidity by "clear and convincing evidence" is part of the traditional presumption of validity).

The broadest-reasonable-construction standard makes sense at both stages of the process. During the initial look, an important ambiguity in the patent is a useful indication that it may be a poor-quality patent that warrants review. During the later thorough scrutiny of the patent, using the broadest reasonable construction of the patent accords with Congress's indication in § 316(e) that the Board should not engage in extraordinary efforts to save a challenged patent, as might a district court. It is not the responsibility of the PTO or the Board to search for a narrower construction to save the patent; it is up to the patent holder to propose an amendment to cure the problem, if the problem can be cured.

2. Petitioner contends (at 26, 33) that, because Congress intended *inter partes* review to serve as a "substitute for district court adjudication," the PTO is bound to avoid "validity decision[s] regarding the same invention" that are "different" from those a court

would reach. Nothing in the statutory text indicates that *inter partes* review is meant to serve as a completely identical "substitute" for district court litigation.[11] On the contrary, Congress contemplated that the Board could reach different results from a district court in several ways – some that favor patent holders, and some that favor challengers. There is no plausible way to read the statute to mandate that all cases must come out alike, regardless of forum, and there is no reason to expect they should.

First, the PTO's initial look at a petitioner's "reasonable likelihood" of success under § 314(a) has no parallel in district court. A claim of invalidity in federal court must be supported only by a "short and plain statement of th[at] claim," Fed. R. Civ. P 8(a)(2), and "may proceed even if it strikes a savvy judge that actual proof of th[e] facts [pleaded] is improbable, and 'that a recovery is very remote and unlikely.'" *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 556 (2007) (quoting *Scheuer v. Rhodes*, 416 U.S. 232, 236 (1974)). Thus, some challenges that the PTO would initially have rejected as unlikely can proceed (and potentially prevail) in court.

Second, entire categories of challenges to a patent are unavailable in an *inter partes* review but permitted in district court. A challenger in an *inter partes* review can assert only challenges under 35 U.S.C. § 102 or § 103. A district court can hear other kinds

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[11] As petitioner acknowledges (at 31-32), *inter partes* review replaced a different administrative procedure, *inter partes* reexamination. *See* H.R. Rep. No. 112-98, at 46-47. Although Congress made changes to that procedure to make it more adversarial, there is no reason to think Congress expected the new procedure to be completely unlike its predecessor and completely like district court litigation.

– for example, an argument that a claim is fatally indefinite under § 112(b).

Third, Congress's restriction of prior art considered in *inter partes* review proceedings to "patents or printed publications," 35 U.S.C. § 311(b), means that some challenges even under § 102 or § 103 will be impossible to bring before the Board. In court, a challenger may introduce as prior art not only anything that was "patented[or] described in a printed publication," but also anything that was "in public use, on sale, or otherwise available to the public" at the relevant time. *Id.* § 102(a)(1). Petitioner's assertion that Congress "intended that the Board and district courts would reach a consistent result based on the same pool of potential prior art," Br. 31, is wrong.

Fourth, the different evidentiary burden makes patents easier to challenge before the Board once the initial hurdles are passed. Congress's refusal to accord patents the presumption of validity that a court would apply shows that Congress viewed *inter partes* review as akin to the agency's reevaluating its own work, as it would do in a reexamination or reissue proceeding. *Cf. Patlex Corp. v. Mossinghoff*, 758 F.2d 594, 604 (describing the purpose of reexamination as, "if need be[,] to remove patents that should never have been granted"), *modified on other grounds on reh'g*, 771 F.2d 480 (Fed. Cir. 1985). In conducting such a reevaluation, it makes sense that the agency would apply the same claim-construction standard that its examiners applied in the original proceeding.[12]

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[12] Congress also authorized the Director to consolidate *inter partes* review with concurrent PTO proceedings involving the same patent. *See* 35 U.S.C. § 315(d). As the Director observes (at 42-43), that authorization indicates Congress anticipated that the PTO would use the same claim-construction standard for

Congress's specification of an evidentiary burden also shows that, where Congress meant to impose procedural or evidentiary rules to govern proceedings before the Board and constrain the agency's discretion, it did so expressly. The absence of language selecting a particular claim-construction standard is therefore a strong reason to conclude – at a minimum – that Congress has "not directly addressed the precise question at issue," *Chevron U.S.A. Inc. v. Natural Res. Def. Council, Inc.*, 467 U.S. 837, 843 (1984), and that the Director's reasonable interpretation warrants deference. *See* Gov't Br. 41-43.

III. *INTER PARTES* REVIEW IS OPERATING AS CONGRESS INTENDED

A. The PTO Has Cancelled an Appropriate Number of Poor-Quality Patents

1. If the PTO and the Board had been cancelling socially valuable, high-quality patents, petitioner and its *amici* would come forward with examples. They cannot. Consider the brief of PhRMA, the voice of the country's largest pharmaceutical and biotechnology companies, which are generally thought to own many of the highest-value U.S. patents. Its lone example (at 20-22) of an *inter partes* petition that threatened a patent for a socially beneficial drug involves a petition filed against a patent for Allergan eye drops. As PhRMA observes, the PTO declined even to institute the *inter partes* review.[13] A case that the patent

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inter partes review as for other administrative proceedings; the efficiency of consolidation would be reduced if the PTO applied different constructions to the same claims in the same proceeding.

[13] *See Ferrum Ferro Capital, LLC v. Allergan Sales, LLC*, Case IPR2015-00858, 2015 WL 5608290 (P.T.A.B. Sept. 21, 2015).

holder won anyway does not make a very effective parade of horribles.

With no meaningful examples of any problem created by the PTO's rule, petitioner and its *amici* instead fall back on statistics. For example, they argue that the Board is cancelling patent claims at an unacceptably high rate because, at year-end 2015, 87% of completed *inter partes* reviews had resulted in at least one claim being cancelled, *see* Pet. Br. 34, as compared to a 42% success rate for invalidity challenges in district court, *see* PhRMA Br. 19. But the statistics petitioner and its *amici* proffer are misleading because they ignore a number of factors, including substantial incentives to challenge only weak patents and the screening function of the PTO's initial, discretionary decision whether to institute an *inter partes* review.

2. Patents challenged in *inter partes* review are likely to be weak ones – or, at least, ones that a challenger believes to be weak. Although less expensive than district court litigation, an *inter partes* petitioner must pay fees estimated to cover the PTO's cost of the proceeding (in addition to its own legal and expert fees that, in *amici's* experience, often are hundreds of thousands of dollars per petition).[14] Seeking review also creates a risk of estoppel. *See* 35 U.S.C. § 315(e) (barring a petitioner that receives a "final written decision under section 318(a)" from asserting invalidity in a district court action or before the International Trade Commission "on any ground that the petitioner raised or reasonably could have raised during that

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[14] *See* Am. Intell. Prop. L. Ass'n, *2015 Report of the Economic Survey* 38 (June 2015) (estimating costs of $200,000 to $350,000 per *inter partes* review), http://files.ctctcdn.com/e79ee274201/b6ced6c3-d1ee-4ee7-9873-352dbe08d8fd.pdf.

inter partes review"). Bringing anything but strong cases to the PTO for *inter partes* review thus increases the likelihood of a later bad result.

The PTO is also more likely to institute review (after a quick look at the merits under § 314(a)) of weak patents. To date, the PTO has declined to institute *inter partes* review on nearly half of the petitions it has received. *See infra* p. 25. High success rates for challengers in instituted cases should be unsurprising – and certainly does not suggest a failure of the process – given that the PTO has already rejected a very substantial number of dubious petitions.

3. A reasonable assessment of the numbers does not support the exaggerated concerns expressed by petitioner and its *amici*. There were nearly 3 million patents in force in the United States in 2015.[15] Only a small fraction of those patents are ever litigated in any forum: about 15,000 patents have been asserted in district court actions in the four years following the enactment of the AIA. *See* RPX Corp., *A Closer Look at Claim Construction in IPR and CBM* 4 (2016) ("*Closer Look*").[16] During that same period, 2,758 patents have been challenged by either a petition for *inter partes* review or a petition under the PTO's related covered-business-methods program. *See id.*

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[15] *See* World Intell. Prop. Org., *Statistical Country Profiles: United States* (last updated Dec. 2015) (approximately 2.5 million patents in force in the United States in 2014), http://www.wipo.int/ipstats/en/statistics/country_profile/profile.jsp?code=US. Nearly 300,000 more U.S. patents issued in 2015. *See* Patently-O, *Patent Grants 2015* (Jan. 13, 2016), http://patentlyo.com/patent/2016/01/patent-grants-2015.html.

[16] https://www.rpxcorp.com/wp-content/uploads/sites/2/2016/03/FinalZ-RPX-White-Paper-Claim-Construction-IPR-CBM-3-10-16-950-AM.pdf.

A significant number of those petitions (41%) did not lead to the institution of any review, and another significant fraction (14%) led to the institution of review as to only some challenged claims. *See id.* at 7. Of those that led to an institution, a significant number (28%) settled or otherwise terminated before a final written decision. *See id.* Taking all factors into account, the PTO has cancelled one or more patent claims in only 43% of completed *inter partes* reviews. *See id.* In summary, only one-tenth of one percent of all existing patents have been challenged; new district court assertions exceed review petitions by more than five to one; and the PTO is cancelling any claims at all in fewer than one in two challenges. Petitioner's 87% figure is not a reasonable description of the situation.

The results for patent holders are even more favorable when broken down claim-by-claim rather than patent-by-patent. The PTO reports that 36,872 claims were challenged within the 2,447 petitions filed that have been completed. *See* PTO, *Patent Trial and Appeal Board Statistics 12/31/2015*, at 12.[17] The Board instituted review of 15,987 claims and found 7,778 claims unpatentable in final written decisions – a claim-invalidation rate of only 21% when measured against the 36,872 claims actually challenged. *See id.*

A better comparison would look at the results from *inter partes* review and covered-business-method review versus the Board's *own* decisions applying the *Phillips* standard (which it uses for expired patents that can no longer be amended). Similar percentages of reviews are instituted, *see Closer Look* 8 (78% under broadest-reasonable-construction standard, 70% under *Phillips*); similar percentages of completed trials lead

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[17] http://www.uspto.gov/sites/default/files/documents/2015-12-31%20PTAB.pdf.

to the cancellation of at least some patent claims, *see id.* (89% under broadest-reasonable-construction standard and 97% under *Phillips*). To be clear, the standard makes a difference in some cases, *see, e.g.*, *PPC Broadband, Inc. v. Corning Optical Commc'ns RF, LLC*, Nos. 2015-1361 et al., 2016 WL 692368, at *4 (Fed. Cir. Feb. 22, 2016) (noting one such instance and suggesting there will be others), and there are reasons to be cautious about inferences from the limited available data.[18] Nevertheless, based on those data, claims of a "nearly threefold" difference in patent-invalidation rates based on the broadest-reasonable-construction standard, Intellectual Ventures Mgmt. Br. 12 & n.3, do not deserve credence.

4. Finally, the rates at which petitioners seek *inter partes* review have begun to flatten out or decline. *See* PTO, *Patent Trial and Appeal Board Statistics 4/30/15*, at 3 (graphing number of petitions filed by month, from September 2012 to April 2015);[19] PTO, *Patent Trial and Appeal Board Statistics 2/29/16*, at 4 (same, from February 2014 to February 2016).[20] Similarly, the proportion of petitions on which the PTO institutes review has fallen steadily since early 2013.[21] The PTO has also become more selective in

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[18] The sample size is small, and the populations being compared are not identical. *See Closer Look* 8.

[19] http://www.uspto.gov/sites/default/files/documents/2015-04-30%20PTAB.pdf.

[20] http://www.uspto.gov/sites/default/files/documents/2016-2-29%20PTAB.pdf.

[21] *See* RPX Blog, *Rising and Falling: IPRs at Institution*, Fig. 1 (Oct. 19, 2015), http://www.rpxcorp.com/2015/10/19/rising-and-falling-iprs-at-institution/; *see also id.* Fig. 3 (showing a declining percentage of cases in which the Board institutes *inter partes* review, from 100% initially to closer to 50% by mid-2015).

the claims as to which it institutes review, choosing more often to review only some of the claims in a patent.[22] Petitioner's description of *inter partes* reviews as "proliferati[ng]," Br. 34, is unfounded.

B. The PTO Has Been Very Successful in the Federal Circuit

Another sign that the *inter partes* review process has been operating as intended is the Board's high success rate in the Federal Circuit – including many cases where there was no question about claim construction, and so the broadest-reasonable-construction standard played no role. As of March 28, 2016, there have been 81 merits appeals decided on *inter partes* review determinations, 50 by summary affirmance and 31 by written opinion.[23] Only 11 decisions did not fully affirm the agency decisions.[24] The agency's overall affirmance rate (86.4%) compares favorably to historical district court affirmance rates when construing claims under the *Phillips* framework (70.5%, *see supra* note 6). That reinforces the conclusion that much of the Board's initial *inter partes* caseload has involved decidedly bad patent claims that should never have issued in the first place.

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[22] *See Closer Look* 9, chart 6 (showing relative increase in partial institutions over time: in early 2013, 8% of outcomes were partial institutions compared to 84% that were full institutions; in late 2015, 17% compared to 50%).

[23] *See* Finnegan, Henderson, Farabow, Garrett & Dunner, LLP, "IPR FWD-Appealed," http://www.aiablog.com/inter-partes-review-ipr; Finnegan, Henderson, Farabow, Garrett & Dunner, LLP, "IPR FWD-Appealed (Rule 36 Judgment)," http://www.aiablog.com/rule-36-judgments-iprs. The 31 written opinions do not include (1) appeals that were dismissed for reasons unrelated to the Board's final decision or (2) the denial of rehearing en banc in this case.

[24] *See id.*

IV. THE PTO'S DECISION TO INSTITUTE REVIEW CANNOT BE APPEALED

Congress has spoken directly to the question whether the Federal Circuit can hear an appeal from the PTO's decision to institute an *inter partes* review: "The determination by the Director whether to institute an inter partes review under this section shall be final and nonappealable." 35 U.S.C. § 314(d).[25] That bar on review by way of appeal of the determination to institute (or not to institute – the bar cuts both ways) is clear.

A. The Text and Structure of § 314 Are Clear

As explained in Part II, *supra*, *inter partes* review involves a two-stage process. In the first stage, the Board takes a quick look at the merits to decide whether a petition for *inter partes* review is reasonably likely to succeed. *See* 35 U.S.C. § 314(a). The Board also considers at this stage whether the petition is procedurally barred.[26] It may take up to three months to complete the institution decision. *See id.* § 314(b). If the Board decides not to institute a review, the process ends there. If it decides to institute a review, the Board conducts a searching review to determine whether the challenged patent claims should be cancelled, culminating in a "final written decision with respect to the patentability of any patent claim challenged by the petitioner and any new claim added" by amendment during the *inter partes* process. *Id.* § 318(a). The Board may take up to a year to

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[25] Section 314(a) empowers the Director to institute *inter partes* review, and she has delegated her authority to the Board. *See Ethicon Endo-Surgery, Inc. v. Covidien LP*, 812 F.3d 1023, 1030-33 (Fed. Cir. 2016) (upholding delegation).

[26] *See* 35 U.S.C. § 315(a)(1), (b) (setting forth bars based on certain prior proceedings in district court).

make its final written decision, and that period may be extended by six months for good cause. *See id.* § 316(a)(11).

Under that statutory structure, "'institution and invalidation are two distinct actions.'" *Achates Reference Publ'g, Inc. v. Apple Inc.*, 803 F.3d 652, 656 (Fed. Cir. 2015) (quoting *Versata Dev. Grp., Inc. v. SAP Am., Inc.*, 793 F.3d 1306, 1319 (Fed. Cir. 2015), *petition for cert. pending*, No. 15-1145 (U.S. filed Mar. 11, 2016)), *cert. dismissed*, 136 S. Ct. 998 (2016). The Board's decision as to institution becomes "final and nonappealable," 35 U.S.C. § 314(d), when made. Its final written decision as to patentability may be appealed under § 319. It would be contrary to Congress's direction to permit an appeal under § 319 from a final written decision to incorporate a challenge to an institution determination under § 314.

Petitioner argues (at 46) that § 314(d) bars merely "interlocutory" appeals of a determination to institute an *inter partes* review. That too is contrary to the text, which says not only that the determination is "non-appealable," but also that it is "final" when it is made. It therefore cannot be treated as an interlocutory decision that is merged into the later final written decision, as petitioner proposes to do.

Petitioner also errs in relying on the presumption favoring judicial review. "Th[e] presumption is rebuttable: It fails when a statute's language or structure demonstrates that Congress wanted an agency to police its own conduct." *Mach Mining, LLC v. EEOC*, 135 S. Ct. 1645, 1651 (2015); *Block v. Community Nutrition Inst.*, 467 U.S. 340, 349 (1984) ("The presumption favoring judicial review of administrative action is just that – a presumption."). Here, the statute's text and structure amply overcome that

presumption; and, as the Director cogently observes (at 46-48), Congress's intent to foreclose review is made even clearer by comparing the broad language of § 314(d) to narrower provisions barring judicial review of only some aspects of decisions to initiate *ex parte* or (pre-AIA) *inter partes* reexaminations.

B. Appeals of Determinations To Institute *Inter Partes* Review Would Run Counter to Congress's Objective of Improving Patent Quality

The statutory bar on appellate review should also be enforced to further Congress's objective of improving patent quality, allowing the Board to cancel claims as unpatentable whether or not the institution decision can be criticized. This case shows why. Petitioner asserts (at 15) that the Board looked at evidence that the challenger had cited respecting claim 17 of the patent and relied on that evidence in also instituting *inter partes* review of claims 10 and 14 of the patent. After a full trial in which the Board found all three claims obvious and unpatentable, petitioner argues (at 48) that claims 10 and 14 should be reinstated because the Board looked at too much evidence in instituting review as to those claims.

Review of such alleged errors would frustrate the statute's "objectives" in light of "its legislative history, and the nature of the administrative action involved." *Block*, 467 U.S. at 345. Congress's decision to allow parties to appeal the Board's patentability decision – but not the initial decision to institute review – plays an important role in creating a "cost-effective alternative to formal litigation," 157 Cong. Rec. S951 (Feb. 28, 2011) (Sen. Hatch), that "screen[s] out bad patents while bolstering valid ones," *id.* at H4426 (June 22, 2011) (Rep. Goodlatte).

Petitioner itself acknowledges (at 15) that interlocutory review of the Board's decision to institute an *inter partes* review would be infeasible because the entire review process must be completed just one year after the decision to institute. *See* 35 U.S.C. § 316(a)(11) (requiring the Board to issue a final written decision within one year of institution). But Congress's goal of efficiency would be equally disserved by overturning a completed *inter partes* review for reasons unrelated to the merits of the patent and then possibly sending the case back for the PTO either to reinstate unpatentable claims or to reconsider the institution decision and restart the process.

If the Board's ultimate decision to cancel a patent claim is itself correct, the public benefits from leaving that decision in effect. *Cf.* Letter from Thomas Jefferson to Isaac McPherson (Aug. 13, 1813) (describing the proper focus of the patent system as "drawing a line between the things which are worth to the public the embarrassment of an exclusive patent, and those which are not"), *reprinted in* 3 *The Founders' Constitution* 42-43 (Philip B. Kurland & Ralph Lerner eds., 1987). Congress reasonably decided that the judicial review should focus on the merits of the agency's decision whether to cancel claims as unpatentable, rather than on the side issues petitioner sought to raise here. And Congress spoke clearly when it did so.[27]

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[27] Once the Board has instituted an *inter partes* review, its decision to cancel or not to cancel a claim as unpatentable may be challenged on appeal on any ground raised in the petition or otherwise properly presented during the proceeding. The bar on review applies only where an objection raised on appeal goes solely to the decision to institute rather than to the merits of the Board's final written decision.

C. Mandamus Should Be Available in Extraordinary Cases

By its terms, § 314(d) states that determinations whether to institute review are "nonappealable." It would be consistent with that language to permit review by mandamus in extraordinary cases where the traditional requirements for that writ are met, including a "clear and indisputable" right, *Cheney v. United States Dist. Court for Dist. of Columbia*, 542 U.S. 367, 380-81 (2004) (internal quotations omitted), that has been violated by an agency decision. Mandamus is traditionally viewed as distinct from "the regular appeals process," *id.*, so a textual bar on appeals can be read to leave open the possibility of judicial intervention on truly unusual facts.

Petitioner does not contend that the requirements for mandamus are met here, and that case-specific question is not within the scope of the petition for certiorari. Even if it were, petitioner's complaint that the Board considered too much evidence in the initial stage of proceedings is the sort of issue that Congress rationally decided was not worth the cost or time of authorizing judicial review. The Board's alleged error does not require unleashing one of "'the most potent weapons in the judicial arsenal.'" *Cheney*, 542 U.S. at 380 (quoting *Will v. United States*, 389 U.S. 90, 107 (1967)). Accordingly, this case can and should be resolved by applying the bar of § 314(d) on ordinary appeals and leaving for another day the question of mandamus authority.

CONCLUSION

The judgment of the court of appeals should be affirmed.

Respectfully submitted,

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ADDENDUM

Amici Curiae

Acushnet Company
Alliance of Automobile Manufacturers
Applied Materials, Inc.
Association of Global Automakers
ASUSTeK Computer Inc.
BJ's Wholesale Club, Inc.
Canon Inc.
Computer & Communications Industry Association
Cisco Systems, Inc.
CTIA – The Wireless Association
Dell Inc.
Demandware, Inc.
Dropbox, Inc.
eBay, Inc.
Fairchild Semiconductor International, Inc.
Google Inc.
Hewlett Packard Enterprise
HTC Corporation
Intel Corporation
The Internet Association
J. C. Penney Corporation, Inc.
L Brands, Inc.
Limelight Networks, Inc.
LinkedIn Corporation
Micron Technology, Inc.
National Retail Federation
Netflix, Inc.
Newegg Inc.

Pegasystems Inc.
QVC, Inc.
Rackspace Inc.
Red Hat, Inc.
Ricoh USA, Inc.
Samsung Electronics Co., Ltd.
SAP America, Inc.
SAS Institute Inc.
Seagate Technology PLC
Symmetry LLC
Toyota Motor Corporation
Varian Medical Systems, Inc.
VIZIO, Inc.
Xerox Corporation